Applicant : Barry Appelman and Stephen Vaughan
Murphy
Serial No. : 10/747,694
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REMARKS

Claims 1, 5-19, 22, 36, 40-54 and 57 are pending in this application, with claims 1 and 36 being independent. Claims 2-4, 20, 21, 23, 25-35, 37-39, 55, 56 and 60-63 have been canceled; and claims 1 and 36 have been amended. No new matter has been introduced.

1. Request for entry of after-final amendment

Independent claims 1 and 36 have been amended to incorporate the limitations of their dependent claims 23 and 58, respectfully. Applicants respectfully request entry of this amendment because the amendment is not believed to introduce any new issues that would require further search or consideration. The amendment merely incorporates already existing dependent claim limitations into the independent claims that have already been searched for and considered by the Examiner.

2. Response to rejections over Isaacs

Independent claims 1 and 36, and their dependent claims, have been rejected as being unpatentable over Isaacs (U.S. Patent No. 6,760,754) in view of Official Notice that it is old and well known that users have been alerted of incoming calls by repeated ringings. Each of independent claims 1 and 36, as amended, recites that the digital communication associated with an audio identifier designated by the sender of the digital communication is a phone call and that the audio identifier is "rendered multiple times in repetition so as to be made perceivable as a ring tone for the phone call." Applicants request reconsideration and withdrawal of the rejection of claims 1 and 26, and their dependent claims, because no proper combination of Isaacs and the Official Notice describes or suggests this limitation.

Isaacs describes a sound instant messaging system in which users of mobile devices are able communicate with each other by sending short pre-recorded sound instant messages to each other. The purpose of Isaacs system is to allow users to send audio messages to each other "without requiring undue amounts of keystrokes, actions or input on the part of the users." See

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col. 9, lines 14-17. When a recipient receives an audio message from a sender, a sound identifier designated by the sender to identify the sender is played prior to the playing of the received audio message.

As acknowledged by the Examiner, Isaacs does not disclose that this sound identifier is "rendered multiple times in repetition in response to receipt of the" audio message, as recited in the claims. See page 3 of Final OA. The Examiner, however, takes Official Notice that such repetition is well known in the art (i.e., it is old and well known that users have been alerted of incoming calls by repeated ringings) and asserts that it would have been obvious, in view of this, to modify Isaac's system to repeat the rendering of the sound identifier multiple times in response to receipt of the audio message. Applicants disagree and assert that the proposed combination is improper.

First, Isaacs does not describe or suggest playing a sound identifier multiple times <u>as a ring tone</u> to identify caller. Rather, Isaacs only describes playing a sound identifier prior to playing a received sound instant message to thereby enable the recipient to identify the sender of the sound instant message. The Examiner takes Official Notice that it is old and well known that users can be alerted of incoming calls by repeated ringings. The messages communicated by the system in Isaacs, however, are not telephone calls but rather are sound instant messages, and, accordingly, absent improper hindsight based on applicant's own disclosure, such a method of alerting would not have been deemed applicable by a person of ordinary skill in the art to Isaacs' system.

Second and importantly, modification of Isaacs in the manner proposed by the Examiner destroys the primary teaching/purpose of Isaacs. Specifically, Isaacs cannot be applied to meet a sender-designated audio ring tone because the primary teaching/purpose of Isaacs is to enable delivery of audio messages between users, which would not accompany a sender-designated audio identifier that functions <u>as a ring tone</u>. That is, Isaacs cannot achieve its primary teaching/purpose in a setting that uses the sound identifier as an announcing ring tone, since an announcing ring tone does not include a non-identifying audio message from a sender. Accordingly, modifying Isaacs to focus on its sound identifier as a ring tone to be delivered in

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the absence of its sound message destroys the primary teaching/purpose of Isaacs, in contravention to well-established doctrine. See, e.g., MPEP 2143.01 (V) and (VI).

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claims 1 and 36, and their dependent claims.

Applicants submit that all claims are in condition for allowance.

No fees are believed due in connection with this filing. If any fees or refunds are due, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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